

Reply Brief

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Dated: March 23, 2009

Electronic Signature for Charles A. Bieneman: /Charles A. Bieneman/

Docket No.: 66703-0014
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Lester K. Chu et al.

Confirmation No.: 1779

Application No.: 10/800,444

Art Unit: 3625

Filed: March 15, 2004

Examiner: N.D. Rosen

For: INFORMATION DISTRIBUTION SYSTEM
AND METHOD THAT ORGANIZES
LISTINGS USING TIERS

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
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Dear Sir:

This Reply Brief is submitted pursuant to 37 C.F.R. § 41.41 and responds to the Examiner's Answer dated March 5, 2009 ("Second Examiner's Answer"). A Notice of Appeal under 37 CFR § 41.31 was filed on August 7, 2007, an Appeal Brief was filed on October 5, 2007, a Supplemental Appeal Brief was filed on November 2, 2007. A first Examiner's Answer was mailed January 11, 2008. A further Supplemental Appeal Brief was then required by the Office, and was filed on January 26, 2009. This latter Supplemental Appeal Brief, to which the Second Examiner's Answer responds, is hereinafter referred to as the "Supplemental Appeal Brief". This application was filed on March 15, 2004.

ARGUMENT

A. Grounds of Rejection Nos. 1-10: The Law.

Instead of providing the required findings of fact and analysis necessary to support a conclusion of obviousness, the Examiner has repeatedly speculated, used improper hindsight reasoning working backwards from Appellants' disclosure, and constructed hypothetical fact scenarios clearly not taught or suggested by the references of record. The Examiner's rank speculation concerning what could have been – but was not – taught or suggested by the prior art of record fails to meet the Examiner's burden of providing a prima facie case of obviousness. Therefore, as argued in the Appeal Brief, and herein below, each of these improper obviousness rejections should be reversed, and the claims allowed.

Obviousness is a question of law, although factually based. See MPEP 2141. The underlying factual inquiries used to provide this basis are as stated in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and as recently affirmed in the United States Supreme Court's recent decision in KSR International Co. v. Teleflex, Inc., 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). These objective factors are: determining the scope and content of the prior art, ascertaining the differences between the claimed invention and the prior art, resolving the level of ordinary skill in the art; and evaluating any objective evidence of nonobviousness (secondary considerations). (MPEP 2141, citing Graham.) Factual findings are made by Patent Office personnel in support of these objective factors, and "are the necessary underpinnings to establish obviousness." (MPEP 2141.)

"An invention that would have been obvious to a person of ordinary skill at the time of the invention is not patentable." (MPEP 2141, citing 35 U.S.C. 103(a).) In making this determination on obviousness, "the examiner bears the initial burden of factually supporting any prima facie conclusion." (MPEP 2142.) The Examiner makes this determination based on the knowledge of a person of ordinary skill in the art at the time the invention was made. (Id.) Moreover, the Examiner may not "resort to 'hindsight' based upon applicant's disclosure." (Id.)

Further, "key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious," and that this analysis must be made "explicit." (MPEP 2141.) In addition, "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness.” (MPEP 2141, quoting KSR, quoting In re Kahn.) Moreover, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” (KSR, 127 S.Ct. at 1731, 82 USPQ2d at 1389.)

B. Ground Of Rejection No. 1: “each said group being determined at least in part according to said request”

Independent claim 1 recites in part “each said group being determined at least in part according to said request.” In the Second Examiner’s Answer, the Examiner repeated his allegation that Appellants’ claim 1 is obvious over the combination of Soulaillie and Bates because “Bates’s [sic] groups are not fully pre-determined, and do change according to the user’s search request.” (Second Examiner’s Answer, page 30.)

However, as admitted in the Final Office Action, Soulaillie fails to disclose the foregoing recitation. (Final Office Action, page 3.) Moreover, as argued in the Appeal Brief, Bates provides a pre-defined, static set of groups, such as visited, unvisited, changed and unchanged URLs. (Supplemental Appeal Brief, pages 23-24.) Although the search results placed in each group may change, the groups themselves do not. Thus, Bates’ static groups in fact teach away from “each said group being determined at least in part according to said request” as recited by claim 1.

C. Ground Of Rejection No. 1: Soulaillie Could Not Have Been Combined With Bates.

Nothing in either reference would have made possible a combination of Soulaillie with Bates, particularly given that the Examiner alleges Soulaillie to operate to teach that “said listings within said tier are ordered in accordance with at least one of” the heuristics recited in claim 1, as explained in the Appeal Brief. (See Appeal Brief, page 24.) Regarding the inability of Soulaillie and Bates to be combined, the Examiner argued in the Second Examiner’s Answer that:

the argument does not match the scope of the claims. Claim 1 does not recite that the listings are ordered according to groups, but simply that the listings are associated with groups. If a search system merely assigned listings to groups for its own purposes, without ordering the listings presented to the user in accordance with the groups, or doing anything else to make the user aware of the existence of the groups, the relevant limitation of claim 1 would still be met. It may be that one could not simultaneously practice all elements of Soulaillie

and all elements of Bates, but such bodily incorporation is not a requirement for a valid finding of obviousness.

(Second Examiner's Answer, page 31.) However, Appellants do not depend on any argument that one could not simultaneously practice all elements of Soulanille and Bates. In fact, Appellants argue that ordering listings based on heuristics as recited by claim 1 is incompatible with ordering the same listings based on groups sorted by priority as taught in Bates. (Supplemental Appeal Brief, pages 24-25.) To get around this clear incompatibility, the Examiner speculated that a search system could assign listings to groups "for its own purposes," not for presentation to the user. However, the Examiner has simply conjured a search system that assigns listings to groups "for its own purposes," which "own purposes" are nowhere suggested by the references.

Moreover, this argument that Bates has groups "for its own purposes" is an implicit admission that Bates fails to teach or suggest "each said group being determined at least in part according to said request" as addressed above. As argued in the Appeal Brief, Bates teaches that its URLs and groups are sorted in order of priority. (Supplemental Appeal Brief, pages 24-25.) Bates further teaches performing this ordering to give more meaningful information to the user. (E.g., Bates, Abstract.) Bates includes absolutely no indication of performing any ordering "for its own purposes." There is no reason for one of ordinary skill in the art reading Bates to have thought that ordering "for its own purposes" would occur, or even that could occur. Here, the Examiner has simply made up elements not taught or suggested by Bates.

Thus, for the foregoing reasons, the present rejection of claim 1 should be reversed.

D. Ground Of Rejection No. 1: Claim 10 Is Separately Patentable.

Claim 10 depends from independent claim 1. Thus, claim 10 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 10 recites in part "said listings belonging to said tier belong to the same said group." In the Second Examiner's Answer, the Examiner continued to rely on hypothetical cases in which additional elements not taught or suggested by Bates, or any of the other references, would be required to ensure that "said listings belonging to said tier belong to the same said group." (Second Examiner's Answer, pages 32-33.)

The Examiner speculated that:

[T]he situation of Examiner's first example would not require that all listings be placed in Bates's highest priority group, but that all listings in a first tier be in Bates's highest priority group.

(Second Examiner's Answer, page 32.) However, regardless of whether the Examiner's speculation would require that all listings be placed in Bates' highest priority group, or that all listings in a first tier be in Bates' highest priority group, the Examiner is continuing to make up elements not taught or suggested by the references. (See Second Examiner's Answer, pages 32-33.) The Examiner's speculation that there may be cases where Bates is not incompatible with "said listings belonging to said tier belong to the same said group" in no way means that Bates in any way teaches or suggests the claim recitation. (Supplemental Appeal Brief, pages 25-26.)

The Examiner's speculations included the following:

Soulanille discloses, for example, that nonpaid listings can follow the paid advertiser listings on a search results page (column 9, lines 18-20). One could thus have a situation, where, as per Soulanille, there are ten paid listings (a first tier), followed by ten non-paid listings (a second tier). If all ten of the paid listings happened to be for URL's [sic] which were new since the last search (as per Bates; this could easily happen if the user's search was for products in a rapidly developing field, or for news articles and opinion columns regarding a swiftly developing crisis), then all of the listings in the first tier would belong to the same group. The second tier, of non-paid listings, might all belong to that group as well, or some second tier listings might be old news, and belong to a different group. Other scenarios would also be possible, again resulting in all of the listings in at least one tier belonging to the same group.

(Second Examiner's Answer, page 32.) Regardless of whether it is possible that a set of conditions could arise wherein all listings in a first tier are paid listings, and all listings in a second tier are non-paid listings, Bates does not state any reason for this to happen, or even any reason to believe there is any likelihood for this to happen. Instead, the Examiner has simply made these elements up.

Further, as argued in the Appeal Brief, the Examiner conceded that, assuming Soulanille and Bates could be combined, which they cannot, at a minimum many instances of search results returned by a combination of Soulanille and Bates would not include "said listings belonging to said tier belong to the same said group." (Supplemental Appeal Brief,

page 25.) Moreover, the Examiner failed to address this concession in the Second Examiner's Answer, providing further reason to reverse the Examiner's rejection of claim 10.

In sum, the Examiner has still failed to provide any reason why one of ordinary skill would have added to the proposed combination of Soulanille and Bates elements taught in neither reference to ensure that "said listings belonging to said tier belong to the same said group," or provided a combination of references that would have taught or suggested "said listings belonging to said tier belong to the same said group." Therefore, for at least the foregoing reasons, claim 10 is separately patentable and the rejection of claim 10 should be reversed.

E. Ground Of Rejection No. 1: Claim 17 Is Separately Patentable.

Claim 17 depends from independent claim 1. Thus, claim 17 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 17 recites "a plurality of responses, said plurality of responses including a first response and a second response, wherein said first response includes said tier and wherein said second response does not include said tier." The Examiner conceded that "Soulanille does not disclose a second response not including a tier of paid listings." (Final Office Action, page 4.) However, the Examiner speculated that additional elements not taught or suggested in the prior art of record may teach or suggest the recitation of claim 17.

In the Second Examiner's Answer, the Examiner addressed claim 17 by setting forth an analogy of a tray for drinks capable of holding up to six drinks, wherein the tray is cited as prior art for a hypothetical claimed tray holding two drinks. (Second Examiner's Answer, pages 33-34.) The Examiner used this analogy to argue that because the prior art tray could hold up to six drinks, then it would be reasonable to presume that there were sometimes two and only two drinks on the prior art tray, thus reading on the claimed tray. (*Id.*) However, the analogy the Examiner put forth is premised on a teaching or suggestion that a tray may hold a variable number of drinks. No analogous teaching or suggestion exists in Soulanille or any other prior art of record. Indeed, the Examiner speculated concerning a drink tray precisely because Soulanille lacks the requisite teachings. In the Second Examiner's Answer, the Examiner admitted that:

... while Soulanille does not disclose a response not including a tier of paid listings, Soulanille does not teach or suggest any way of guaranteeing that there will be a sufficiency of

advertisers, or any advertisers at all, interested in paying to give their listings prominence in the results provided for every possible search request.

(Second Examiner's Answer, page 34.) Thus, the Examiner argued not that the reference teaches or suggests the claim recitation, but instead that the reference fails to teach that the Examiner's hypothetical scenario is impossible.

The Examiner continued that:

Perhaps no potential advertiser will think that a particular search term or set of terms is likely to lead to a purchase, or perhaps no potential advertiser will think of a particular term before it's entered as a search request, or perhaps no potential advertiser will think that a particular search engine is worth advertising on, at least at the fees for paid listings which the search engine charges. Thus, the situation of no paid listings could easily arise in the system disclosed by Soulanille.

(Second Examiner's Answer, page 34.) Thus, the Examiner speculated repeatedly that "perhaps" various events may occur. However, "perhaps," by definition, also means "perhaps not." In fact, the Examiner's statement that the "situation of no paid listings could easily arise" is a clear admission that Soulanille makes no such teaching or suggestion for "the situation of no paid listings." As argued above and in the Appeal Brief, the Examiner's continued speculation is an insufficient basis on which to maintain the rejection of claim 17. (Supplemental Appeal Brief, page 26.)

Additionally, in the Second Examiner's Answer, the Examiner argued that:

A further consideration, set forth in the rejection of claim 17, and not addressed in Appellants' argument, is that even aside from the possibility of a response without paid listings, a second response, responding to a different search from that which triggered a first response, would generally not include the same set of paid listings as a first response, and would in that sense not include "said tier."

(Second Examiner's Answer, page 34; emphasis added.) First, regardless of whether Appellants addressed the foregoing "consideration," Appellants' purported silence is not an admission. Second, the Examiner continued to speculate concerning hypothetical elements not taught or suggested by the references. The Examiner once again speculated, without support, that there is a possibility of a response without paid listings. Moreover, the Examiner further speculates that "said plurality of responses" are responding to different

searches, a recitation not present in claim 17. The Examiner's continued speculation, especially when combined with a mischaracterization of Appellants' claims as done here, is an insufficient basis on which to maintain the rejection of claim 17.

For at least these reasons, claim 17 is separately patentable, and the rejection of claim 17 should be reversed.

F. Ground Of Rejection No. 1: Claim 27 Is Separately Patentable.

Claim 27 depends from claim 26, which depends from claim 1. Thus claim 27 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 27 recites "[t]he system of claim 26, wherein said tier includes three said listings." In the Second Examiner's Answer, the Examiner stated that:

. . . the eight listings in [Soulanille] Figure 7 do include three listings, although not only three. As the honorable members of the Board are surely well aware, there is an important distinction in patent claim language between "includes" or "comprises" and "consists of"; hence, a tier which consists of eight listings includes three listings.

(Second Examiner's Answer, pages 34-35.) However, the Examiner's argument fails to address the recitation of claim 27. As argued in the Appeal Brief, Soulanille's Figure 7 does not contemplate tiers of a specified size, let alone tiers of three listings each, and in contrast merely discloses to show all the available paid listings, padded with unpaid listings to complete the screen. (Supplemental Appeal Brief, page 26.) Thus, for at least the foregoing reasons, claim 27 is separately patentable, and the rejection of claim 27 should be reversed.

G. Ground Of Rejection No. 2: Claims 2 And 3 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Weidlich.

Claim 2 depends from claim 1, and claim 3 depends from claim 2. Claims 2 and 3 are therefore patentable for at least the reasons discussed above with regard to claim 1. Moreover, claim 2 recites, "a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier." In the Second Examiner's Answer, the Examiner stated that:

Soulanille discloses an administrative subsystem, as set forth in the rejection of claim 1, and not traversed by Appellants. It is not necessary that a secondary reference disclose details of the subsystems of which a search engine is comprised; it is sufficient that Weidlich teaches multiple factors for assigning

weight to Web pages, and therefore selectively identifying Web pages for inclusion in search results.

(Second Examiner's Answer, page 35.) First, Appellants did not ever, and do not, admit that Soulanille discloses an administrative subsystem. Second, Appellants respectfully disagree that Weidlich may still teach "a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier" without teaching an "administrative subsystem." Indeed, as argued in the Appeal Brief, Weidlich merely discloses an internet spider that uses an algorithm to determine relevancy when compiling an index keyed by search keywords. Weidlich includes no teaching or suggestion of an "administrative subsystem," let alone "a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier." (See Appeal Brief, pages 26-27.) Moreover, Weidlich further fails to teach or suggest tiers. (See Id., page 28.)

Thus, for at least the foregoing reasons, claims 2 and 3 are separately patentable, and the rejections of claims 2 and 3 should be reversed.

H. Ground Of Rejection No. 3: Claims 28 And 29 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Official Notice.

Claim 28 depends from independent claim 1. Claim 29 depends from claim 28. Thus, claims 28 and 29 are patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 28 recites "a plurality of tiers, a plurality of responses, a plurality of requests, and a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests." In the Second Examiner's Answer, the Examiner stated that the "Examiner took untraversed official notice that it is well known to apply different variations of a technique in different cases." (Second Examiner's Answer, page 36.) However, as stated in the Appeal Brief, Appellants timely traversed the Examiner's Official Notice. (Supplemental Appeal Brief, page 29.) Moreover, the Examiner's Official Notice does not address the language of claim 28.

Without specifically addressing the claim language "wherein a number of said tiers and said tier processing rules differ for different said requests," the Examiner simply constructed from whole cloth subject matter to meet the limitations of claim 28:

Soulanille discloses a number of variants and possible embodiments of his invention; to take one example, in the

context of Soulanille's disclosed weighted random placement of listings, Soulanille discloses, "This method can be adjusted along a continuum from the totally-random display ranking just described, to the strict deterministic bid ranking of the preferred embodiment, by varying one or more parameters of a suitable algorithm" (column 22, lines 14-18). Thus, if after processing a first request, the operator of Soulanille's system were to say, "This isn't getting as much business for our search engine as I'd like. Let's vary one or more parameters of our algorithm to use a different variation," and then process a second request differently, the limitations of claim 28 would be met.

(Second Examiner's Answer, pages 36-37.) However, as argued in the Appeal Brief, the purported prior art of applying "different known variations of a technique in different cases" does not in any way teach or suggest "a number of said tiers and said tier processing rules differ[ing] for different said requests." That is, the Examiner's Official Notice said no more than that it is known to conduct experimentation, but claim 28 does not recite conducting experimentation. (Supplemental Appeal Brief, page 29.) Here, there is absolutely no reason why knowledge of "apply[ing] different and known variations" would have in any way suggested an implemented system requiring that "said tier processing rules differ for different said requests."

Thus, for at least the foregoing reasons, claims 28 and 29 are separately patentable, and the rejections of claims 28 and 29 should be reversed.

I. Ground Of Rejection No. 4: Claim 30 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Schena.

Claim 30 depends from independent claim 1. Thus, claim 30 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 30 recites, "[t]he system of claim 1, further comprising a user location, wherein said system automatically includes said user location as part of said request." The Examiner cited various sections of KSR, and then stated that:

The particular application of this to claim 30 is that there are a finite number of identified, predictable solutions for determining user location, and a design need or market pressure to solve the problem of doing so, namely, recommending conveniently located merchants, rather than those far off. Automatically including the user's location leads to anticipated success, and should thus be considered the

product of ordinary skill and common sense, not patentable innovation.

(Second Examiner's Answer, pages 37-38.) However, nowhere does the Examiner's argument explain how a hypothetical goal of "recommending conveniently located merchants" would render obvious the claim recitation "further comprising a user location, wherein said system automatically includes said user location as part of said request." (Emphasis added.) Moreover, nowhere does the Examiner make a finding that that this was a recognized problem or need in the art, a finding that there are finite number of identified, predictable potential solutions, and a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success, as required by KSR. KSR, 127 S.Ct. at 1742, 82 USPQ2d at 1397. These are findings that the Examiner has the burden to provide in order to establish a prima facie case of obviousness. (MPEP 2143.) Indeed, in cases where a user may want to search for a conveniently located merchant, it would make just as much sense for the user to manually include the location as a search term. At most, the Examiner's argument merely states the inclusion of the user's location may be possible, without regard to "automatically includ[ing] said user location," let alone "wherein said system automatically includes said user location as part of said request."

Therefore, for at least the foregoing reasons, claim 30 is separately patentable, and the rejection of claim 30 should be reversed.

J. Ground Of Rejection No. 5: Claim 33 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, Mangold, And An Article By Mahanta et. al Entitled "BT dotcom."

Claim 33 depends from claim 32, which depends from claim 31, which depends from independent claim 1. Thus, claim 33 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 33 further recites "a number of hits and a period of time in which to measure said number of hits, wherein said number of hits in said period of time influence said variable per-hit fee."

In the Second Examiner's Answer, the Examiner stated that:

Appellants describe Examiner as relying on unsupported Official Notice, which is not accurate; Examiner does not rely on Official Notice at all in rejecting claim 33. Mahanta teaches that the fee for paid ads can be contingent on a minimum number of impressions or click-throughs, which means that if the minimum number of hits is not reached, there will be either

no fee paid, or a reduced fee. Thus, the fee per hit depends on the number of hits, presumably within a period of time.

(Second Examiner's Answer, page 39.) However, earlier in the Second Examiner's Answer, the Examiner appeared to take Official Notice on this very point, for example on page 17, where the Examiner stated that "it is well known for a number of hits or a period of time to influence a per-hit fee, as taught in Mahanta." (Second Examiner's Answer, page 17.) Indeed, even in the Examiner's denial of the taking of Official Notice, the Examiner continued to take Official Notice, stating "the fee per hit depends on the number of hits, presumably within a period of time," without any support in the references of record. (Second Examiner's Answer, page 39.)

Additionally, the cited prior art does not in fact teach or suggest "a number of hits and a period of time in which to measure said number of hits, wherein said number of hits in said period of time influence said variable per-hit fee." As stated in the Appeal Brief, the cited section of Mahanta discusses accounting issues related to recognizing revenue from banner advertisements, not a "variable per-hit fee," let alone "said number of hits in said period of time influence said a variable per-hit fee." (Supplemental Appeal Brief, pages 30-32.) Therefore, the rejection of claim 33 should be reversed at least for the foregoing reasons.

K. Ground Of Rejection No. 6: Claim 33 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, Acres, And Mahanta.

As stated above, claim 33 depends from claim 32, which depends from claim 31, which depends from independent claim 1. Thus, claim 33 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, Claim 33 recites "[t]he system of claim 32, further comprising a number of hits and a period of time in which to measure said number of hits, wherein said number of hits and said period of time influence said variable per-hit fee." Although Acres was not cited as disclosing any specific elements of claim 33, Acres was cited as allegedly disclosing "variable per-hit fees (paragraph 6)" with regard to claim 32, from which claim 33 depends.

As argued in the Appeal Brief, one of ordinary skill in the art would not have thought it possible to combine Acres with Soulanille, Bates, or any other reference. (Supplemental Appeal Brief, page 32.)

In the Second Examiner's Answer, the Examiner responded to this argument, stating that:

Acres is not concerned with search terms, but Examiner maintains that that is not necessary. In response to Appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

(Second Examiner's Answer, pages 39-40.) However, as stated in the Appeal Brief, the structures of Soulanille and Bates require search terms from which listings are provided, but Acres lacks this necessary element. (Supplemental Appeal Brief, page 31.) Here, the Examiner makes a clear admission that Acres does lack this element and thus is irrelevant; the Examiner clearly states that "Acres is not concerned with search terms." Indeed, Soulanille and Bates would be rendered inoperable by requiring the system to provide "appropriate" listings for a user without the user inputting search terms.

Further, Appellants respectfully disagree with the Examiner's assertion that Appellants are "attacking the references individually." Appellants argue that one of ordinary skill in the art would not have thought it possible to combine Acres with Soulanille, Bates, or any other reference. Clearly, Appellants are responding to the Examiner's alleged combination of references, and not merely Acres alone.

The Examiner further stated that "Acres teaches charging higher per-hit fees to reach more desirable audiences, and thus teaches variable per-hit fees." (Second Examiner's Answer, page 40.) However, as argued in the Appeal Brief, Acres teaches away from providing listings based on search terms because Acres teaches and suggests displaying "appropriate" content based on collected personal information for the currently identified user, without user input, apart from, potentially, a user login. (Supplemental Appeal Brief, pages 32-33.)

For at least the foregoing reasons, Acres cannot be combined with Soulanille or Bates. Thus, claim 33 is separately patentable and the rejection of claim 33 should be reversed.

L. Ground Of Rejection No. 7: Claim 34 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Acres.

1. Claim 34.

Claim 34 depends from claim 1. Thus, claim 34 is patentable at least for the reasons discussed above with regard to claim 1. As mentioned above with regard to claim 33, Acres cannot be combined with Soulanille and Bates, and even assuming that Acres can be

combined with Soulanille and Bates, which it cannot, the combination still fails to teach or suggest all elements of claim 34.

In the Second Examiner's Answer, the Examiner stated that:

Acres expressly teaches that advertisers may pay displaying sites (a) for each time that a user accesses a web page of the displaying site that includes the advertisement, (b) an additional amount each time a user clicks through the advertisement to access a web page of the advertised web page, and (c) a referral fee that is a percentage of the price of a purchase that resulted from the click through. Examiner submits that at least (b) and (c) are per-hit fees, and the two of them constitute plurality.

(Second Examiner's Answer, pages 40-41.) However, as argued in the Appeal Brief, at most Acres discloses one per-hit fee type, not "a plurality of per-hit fee types." (Supplemental Appeal Brief, pages 33-34.) Regarding the Examiner's submission "that at least (b) and (c) are per-hit fees, and the two of them constitute plurality," Acres states that "(c)" is "a referral fee that is a percentage of the price of a purchase." Clearly, a referral fee is not a per-hit fee, as the referral fee is determined as a percentage of a purchase price, not "per-hit." Thus, "(b)" alone would not constitute a plurality. Therefore, Acres fails to teach or suggest "a plurality of per-hit fee types," as recited in Appellants' claims. For at least the foregoing reasons, claim 34 is separately patentable, and the rejection of claim 34 should be reversed.

2. Claim 35.

Claim 35 depends from claim 34, which depends from claim 1. Thus, claim 35 is patentable at least for the reasons discussed above with regard to claims 1 and 34. Moreover, claim 35 recites, "[t]he system of claim 34, wherein said plurality of listings includes a first listing, wherein said first listing is associated with more than one said per-hit fee type." In the Second Examiner's Answer, the Examiner stated that:

Appellants argue that there is no explicit teaching in Soulanille or Acres . . . Examiner replies that if it is obvious for listings in general to be associated with a plurality of per-hit fee types, and Acres makes this obvious, then it is obvious for the first listing in particular. Neither Soulanille nor Acres says anything to suggest that what is done for listings or advertisements in general cannot be, or should not be, or is not, done for the first listing in a set.

(Second Examiner's Answer, page 41.) However, Appellants disagree with the characterization of Appellants' argument for the patentability of claim 35 as being that "there is no explicit teaching."

Actually, Appellants argued in the Appeal Brief that the Examiner failed to point to any passage in Soulanille, Bates, Acres, or any other prior art reference that allegedly discloses the claim recitation that "said first listing is associated with more than one said per-hit fee type." (Supplemental Appeal Brief, pages 34-35.) Instead of citing to anything taught or suggested by the references, the Examiner in fact appears to concede this point instead by speculating that, at most, the references are not totally incompatible with "said first listing is associated with more than one said per-hit fee type. As argued above and in the Appeal Brief, the Examiner's continued speculation is an insufficient basis on which to maintain obviousness rejections, including the rejection of claim 35.

Moreover, as argued in the Appeal Brief, the Examiner's continued lack of support for this point continues to reinforce the fact that none of the prior art references teach or suggest at least, "wherein said first listing is associated with more than one said per-hit fee type." (*Id.*) Therefore, for at least the foregoing reasons, claim 35 is separately patentable, and the rejection of claim 35 should be reversed.

M. Ground Of Rejection No. 8: Claims 38-42 And 44-46 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, The Anonymous Article "Google Comes Out Ahead," And Bates.

1. Claim 38.

Claim 38 recites in part "each said group being determined at least in part according to said request." Thus, as argued in the Appeal Brief, independent claim 38, as well as all claims depending therefrom, are patentable for at least the reasons discussed above with regard to claim 1. Moreover, claim 38 recites in part that "said administrative rules provide for ordering said listings included in said response." In the Second Examiner's Answer, the Examiner essentially repeated his rejections of this claim recitation, further stating that:

[I]t is well known to prioritize listings in non-paid tiers returned by search engines, as taught by "Google Comes out Ahead." Appellants describe this article as making the conclusory statement that results returned by Google are "most useful and relevant," without any disclosure regarding "ordering listings included in said response." Examiner replies that Appellants are demonstrably mistaken about what the

"Google Comes out Ahead" article teaches. It says, "Google has become the search engine of choice for many Web users due to its uncanny ability to consistently rank the most useful and relevant sites as highest on the list." Therefore, it definitely is concerned with ordering the listings included in responses.

(Second Examiner's Answer, page 41-42.) However, the cited article fails to teach or suggest "said administrative rules provide for ordering said listings included in said response." In fact, the article merely states that Google allegedly is used because it "consistently rank[s] the most useful and relevant sites as highest on the list." Nowhere does the article provide any supporting evidence or details for how this ordering may be performed or by what it may be performed, if indeed any ordering is performed at all. Moreover, the article fails to explain how Google's results are "most useful and relevant." Indeed, the article no more teaches ranking of listings than it teaches creating a search engine with "uncanny ability." Clearly, nowhere does the article contain statements that teach or suggest any aspects of listing ordering, let alone that "said administrative rules provide for ordering said listings included in said response," as recited by claim 38.

Thus, the rejection of claim 38, as well as all claims depending therefrom, should be reversed.

2. Claims 45-46.

Claim 45 depends from claim 40, which depends from independent claim 38. Claim 46 depends directly from independent claim 38.

Thus, claims 45 and 46 are patentable at least for the reasons discussed above with regard to claim 38. Moreover, each of claims 45 and 46 recite in part "said second listing is given a more favorable placement than said first listing." In the Second Examiner's Answer, the Examiner stated that:

Soulanille, as Appellants admit, discloses a weighted random scheme, in which "the probability for the highest bidder to appear in the top spot of N displayed listings is greater than $1/N$ but less than unity, with similar probabilities for the other bidder ranks to land in various display ranks" (column 22, lines 7-18). Appellants make the astonishing argument that just because an event (listings of higher rank or priority appearing below those of lower rank or priority some of the time) is capable of occurring does not mean that Soulanille teaches or suggests that it occurs. Examiner replies that if the disclosure of Soulanille is carried out exactly as Soulanille discloses, with

a probability less than unity for the highest-fee listing to be given first place, than it would very much be expected to occur. To return to Examiner's earlier analogy, this is like arguing that a prior art disclosure of a tray enabling a waiter to carry from one to six drinks does not teach or suggest carrying two drinks on the tray, because there is no explicit teaching of that situation occurring.

(Second Examiner's Answer, pages 42-43.) However, as argued above with regard to the analogy, nowhere is there any corresponding teaching or suggestion in the references of record of a tray that may hold one to six drinks, and thus the analogy is improper. Moreover, if the Examiner's erroneous assertion that all that is required to find a claim recitation obvious is that it be possible for certain events to occur, then no claims would ever be patentable. In effect, the Examiner is arguing that because Soulanille teaches random ordering, and because random ordering may in some cases result in a particular identified ordering, then all other methods of ordering that may potentially come to the same result are also obvious. However, Appellants claim 45 and 46 each recite systems, wherein "said second listing is given a more favorable placement than said first listing," not a specific ordering.

Moreover, as argued in the Appeal Brief, in contrast to where "said second listing is given a more favorable placement than said first listing," Soulanille teaches weighted random ordering, a completely unrelated method. (Supplemental Appeal Brief, page 36.) In fact, random ordering of listings teaches away from any deterministic ordering of listings, including "said second listing is given a more favorable placement than said first listing."

Therefore, Soulanille fails to teach or suggest at least these elements of claims 45 and 46, and for at least the foregoing reasons, claims 45 and 46 are separately patentable. Thus, the rejections of claims 45 and 46 should be reversed.

N. Ground Of Rejection No. 9: Claims 49 And 52-56 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Watanabe, And Bates.

Claim 49 recites in part "each said group being determined at least in part according to said request." As mentioned above, claim 49, as well as all claims depending therefrom, are patentable for at least the reasons discussed above with regard to claim 1. Moreover, as argued in the Appeal Brief, one of ordinary skill would not have thought it possible to combine Watanabe's buddy list message forwarding with Soulanille and Bates.

(Supplemental Appeal Brief, page 37.) In response, in the Second Examiner's Answer, the Examiner stated that:

[T]he test is not whether one could or would be motivated to bodily incorporate the system of Watanabe into that of Soulanille. Examiner merely used Watanabe as example of the well-known technique of inputting programs, files, and particular criteria into computers, something which Appellants surely cannot claim to have invented, and something which is well known and widely used to input many different kinds of programs, files, and criteria into computers. For example, Soulanille discloses, "This method can be adjusted along a continuum from the totally-random display ranking just described, to the strict deterministic bid ranking of the preferred embodiment, by varying one or more parameters of a suitable algorithm" (column 22, lines 14-18), which would require inputting information on how one wishes to vary the parameter(s). Some particular tier criteria might be novel, but merely inputting tier criteria in order to make the system operate cannot be.

(Second Examiner's Answer, page 44.) However, Appellants' claim 49 does not recite "inputting programs, files, and particular criteria into computers," and thus the Examiner's argument is inapplicable in that it misrepresents the recitations of Appellants' claim 49.

In contrast to the Examiner's mischaracterization, claim 49 recites in part, "inputting the tier criteria to define the number of tiers in the response and the number of listings within the tiers." As the Examiner admitted, "[s]ome particular tier criteria might be novel." Indeed, Appellants argue here and in the Appeal Brief that "tier criteria to define the number of tiers in the response and the number of listings within the tiers" is novel. (Supplemental Appeal Brief, pages 37-38.) The Examiner failed to provide any references teaching or suggesting this claim recitation, and thus the Examiner failed to meet the burden of providing a prima facie case of obviousness.

Moreover, as argued in the Appeal Brief, mere disclosure of the inputting of data, without more, is insufficient to support a combination of Watanabe with Soulanille and Bates. (Supplemental Appeal Brief, pages 37-38.)

Therefore, for at least these reasons the rejection of claim 49, as well as all claims dependent therefrom, should be reversed.

O. Ground Of Rejection No. 10: Claim 50 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Watanabe, Bates, And Official Notice.

Claim 50 depends from claim 49. Thus, claim 50 is patentable at least for the reasons discussed above with regard to claim 49. Moreover, claim 50 recites "[t]he method of claim 49, further comprising associating a particular type of placement heuristic to coincide with a particular type of request."

In the Second Examiner's Answer, the Examiner stated that:

Appellants did not expressly mention the taking of official notice in claim 50, still less traverse, still less "specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well known in the art."

(Second Examiner's Answer, pages 45-46.) However, as stated in the Office Action Response of February 15, 2007:

With respect to each instance in which Official Notice has been taken, Applicants hereby seasonably challenge the Official Notice taken by the Examiner. See 37 CFR 1.104(d)(2) and MPEP § 2144.03. Therefore, the Examiner is required to produce documentary proof as evidence of the Official Notice in response to this communication. In the event that the Examiner does not produce documentary proof, it is respectfully submitted that the rejections based on Official Notice – i.e., the rejections of claims 2, 3, 25, 28, 29, 33, 38-47, and 49-56 – must be withdrawn for at least this reason.

(Office Action Response of Feb. 15, 2007, page 14.) Thus, as argued in the Appeal Brief, Appellants seasonably and expressly challenged the Official Notice taken by the Examiner, and respectfully requested for the Examiner to provide support for the Official Notice. The Examiner did not provide such support. (Supplemental Appeal Brief, pages 38-39.) The rejection of claim 50 should be reversed for at least this reason.

In the Second Examiner's Answer, the Examiner further stated that:

Appellants seek to dismiss as mere speculation Examiner's conclusion that, "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to associate a particular type of placement heuristic to coincide with a particular type of request, for the obvious advantage of placing listings likely to be of greater interest to the user, or value to advertisers, in more prominent positions." Examiner replies that this is not mere speculation or

unsupported conjecture, because the rejection of claim 50 includes an explicit example: "(an example would be using placement heuristics which involve geographical categorization in response to search request which include geographical limitations or preferences)."

(Second Examiner's Answer, page 46.) Appellants respectfully submit that it is insufficient for the Examiner to speculate concerning an example, and, then, when challenged, to defend the speculation with an unsupported statement that the example is "not mere speculation or unsupported conjecture." Nowhere does the prior art of record teach or suggest "comprising associating a particular type of placement heuristic to coincide with a particular type of request," let alone teach that this turn of events even would be possible, let alone likely. This is yet another example of where the Examiner's mere speculation on what may be compatible with the prior art fails to meet the Examiner's burden in providing a showing of a prima facie case of obviousness. Further, as argued in the Appeal Brief, the Examiner's continued use of Official Notice on this point reinforces the fact that none of the prior art references teach or suggest at least, "associating a particular type of placement heuristic to coincide with a particular type of request." (Supplemental Appeal Brief, pages 38-39.)

Moreover, the Examiner improperly added a new ground of rejection in the Second Examiner's Answer, additionally citing the Might reference not previously cited against claim 50. The rejection of claim 50 should be reversed for at least this reason. Specifically, the Examiner stated:

Might et al. (U.S. Patent Application Publication 2003/0177076), which was relied upon in rejecting claims 8 and 11, among others, is explicit about optionally returning search results according to category and/or geography, depending on circumstances, and could have been applied to claim 50 if the taking of official notice had been properly traversed. Appellants, having presumably read the Office Action with some care, could scarcely have thought that Examiner's example of geographical categorization was merely the fruit of Examiner's own imagination. Thus, there is sound basis for the statement of motivation in Examiner's rejection of claim 50, and the rejection should be upheld.

(Second Examiner's Answer, page 46.) However, claim 50 recites in part, "further comprising associating a particular type of placement heuristic to coincide with a particular type of request," not "optionally returning search results according to category and/or

geography.” Thus, not only is the Examiner’s new ground of rejection improper, but moreover, it completely fails to address the subject matter of claim 50. If there is “sound basis” for the Examiner’s obviousness rejection of claim 50, then the Examiner has the burden of making that prima facie case. Merely providing an unsupported example indicates that such a rejection, in the Examiner’s own words, is the “fruit of the Examiner’s own imagination,” and not supported by the prior art of record.

In sum, for at least the aforementioned reasons, claim 50 is separately patentable and the rejection of claim 50 should be reversed.

CONCLUSION

In view of the foregoing arguments, Appellants respectfully submit that the pending claims are novel over the cited references. The Examiner's rejections of all pending claims are improper because the prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 66703-0014, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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Respectfully submitted,

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